

REMARKS/ARGUMENTS

Applicants request reconsideration of the objection to claims 1, 4, 9, 18, 19, and 20. Applicants have amended the claims in the manner suggested by the Examiner. It is believed that the objection may now be withdrawn.

Applicants request reconsideration of the rejection of claim 10 under 35 U.S.C. §112, second paragraph, as being indefinite. Claim 10 has been canceled by this Amendment. In view of the amendment, it is believed that the §112 rejection should be withdrawn.

Applicants request reconsideration of the rejection of claims 1, 7-9, 16, and 17 under 35 U.S.C. §102(b) as being anticipated by D'Agostino, U.S. Patent No. 5,231,571. Applicants have amended claims 1 and 9, the base independent claims, to include the patentable feature of the controlling means comprising different levels of control with a first level of control being the computer system sending screens to the computer, a second level of control being the computer system controlling operation of the web enabled program of the computer, and a third level of control being the computer system capturing complete control of the computer. The D'Agostino reference does not disclose such a feature. The Examiner has pointed to Column 4, lines 43-46 and lines 59-62. However, a reading of such citations does not disclose or teach that there are different levels of control as Applicants have claimed. The D'Agostino reference is merely referring to the capability of displaying different screens on the customer computer. In complete contrast, Applicants now claim different levels of control with one of the levels of control being the computer system controlling operation of the web enabled program

of the customer computer. The D'Agostino reference is completely devoid of any disclosure of such a feature. Further, the D'Agostino reference is also lacking any disclosure that the customer computer has a web enabled program. It is to be further emphasized that D'Agostino is a dedicated self-contained system. While Applicants have claimed a system that is not dedicated. In particular, Applicants' system is capable of allowing a customer to search the Internet for goods and services and is not tied to one particular company as is disclosed in the D'Agostino reference.

Further, with respect to the specific rejection of claims 8 and 17, the Examiner has pointed to Column 13, line 68 to Column 14, line 2 for the proposition that the D'Agostino reference discloses a first window and a second window and that the windows are displayed simultaneously. However, such cited section of the reference does not disclose a first window and a second window and that the windows are displayed simultaneously. Such referred to section of the reference only indicates that the display shown on the customer's terminal is also shown on the representative's terminal. There is no disclosure of the display 44 of the representative terminal 12 being able to have two different windows displayed at the same time.

In view of the amendments to the base independent claims 1 and 9, it is believed that the rejection of claims 1, 7-9, 16, and 17 under 35 U.S.C. §102(b) as being anticipated by D'Agostino should be withdrawn.

Applicants request reconsideration of the rejection of claims 1-4 and 9-12 under 35 U.S.C. §102(b) as being anticipated by Thean et al., U.S. Patent No. 6,397,036. Again, Applicants have amended claims 1 and 9, the base independent claims, to include the patentable feature of the controlling means comprising different levels of control with

a first level of control being the computer system sending screens to the computer, a second level of control being the computer system controlling operation of the web enabled program of the computer, and a third level of control being the computer system capturing complete control of the computer. The Thean et al. reference does not disclose such a feature. Further, the Examiner, in an attempt to show where in the Thean et al. reference there is shown controlling means, has vaguely referenced the operating system, OS in Figure 2. However, a review of Figure 2 leads to the conclusion that there is no controlling means or operating system shown or disclosed. In view of the amendments to the base independent claims 1 and 9, it is believed that the rejection of claims 1-4 and 9-12 under 35 U.S.C. §102(b) as being anticipated by Thean et al. should be withdrawn.

Applicants request reconsideration of the rejection of claims 5, 6, 13, and 14 under 35 U.S.C. §103(a) as being unpatentable over D'Agostino. In rejecting claims under 35 U.S.C. §103, it is incumbent upon the Examiner to provide a reason why one having ordinary skill in the art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion, or inference in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. *Uniroyal, Inc. v. Rudkin-Wiley*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984); *In re Sernaker*, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983). It is imperative for the decision maker to place himself back in time to when the invention was unknown, i.e., without the Applicants' disclosure as his side, and determine, in light of all the objective evidence bearing on the

issue of obviousness, whether one having ordinary skill in the art would have found the claimed invention as a whole obvious under 35 U.S.C. §103. *Panduit v. Dennison Mfg. Co.*, 774 F.2d 1082, 227 USPQ 337 (Fed. Cir. 1985), vacated 475 U.S. 809, 229 USPQ 478 (1986), *aff'd* on remand, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987). It should be recognized that the fact that the prior art could be modified so as to result in the combination defined by the claims in the application would not have made the modification obvious unless the prior art suggests the desirability of the modification. *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986).

With respect to the rejection of claims 5 and 13, the Examiner has taken the position that D'Agostino does not disclose a wireless connection but that wireless connections have been known for years and it would have been obvious to convert the telephone connection 16 of D'Agostino into a wireless connection. The Examiner has not cited any references for this position. Further, with respect to the rejection of claims 6 and 14, the Examiner states that a hand held computer was known and that it would have been obvious to replace the computer disclosed in the D'Agostino reference with a hand held computer. Again, the Examiner has not cited any references for this proposition.

The Examiner's reasoning is faulty on two counts. First, as stated above, there must be some reason why one having ordinary skill in the art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion, or inference in the prior art as a whole. There is simply no teaching concerning wireless connections or hand held computers and the Examiner has not pointed to any teaching, suggestion, or inference in

the prior art which would show this. For example, the D'Agostino reference does not teach or suggest a wireless connection or a hand held computer and none of the other references cited by the Examiner teach or suggest the desirability of making such a modification to the D'Agostino reference. The Examiner must then make an unsupported leap to the conclusion that wireless connections or hand held computers are well known without citing any support in the references. D'Agostino, as the Examiner has acknowledged, does not teach or suggest the desirability of using a wireless connection or a hand held computer. Absent some teaching, suggestion, or inference in the prior art, the §103 rejection is improper.

Second, the Examiner's conclusion that a wireless connection or a hand held computer is well known in the art is mere speculation based on impermissible hindsight. A rejection based on 35 U.S.C. §103 must rest on a factual basis. The U.S. Patent and Trademark Office has the initial duty to supply the factual basis for such a rejection. It may not, because it may doubt an invention is patentable, resort to speculation, unfounded assumptions, or hindsight reconstruction to supply deficiencies in its factual basis. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967). The Examiner has apparently relied on speculation, based on having Applicants' disclosure before him, in concluding that it would have been obvious to use a wireless connection or a handheld computer. As recognized by the Examiner, D'Agostino is completely devoid of any suggestion, teaching, or inference concerning use of a wireless connection or a handheld computer. As the courts have frequently warned the use of "hindsight" in determining obviousness is improper. In the case of *In re Manurkar Patent Litigation*, 28 USPQ2d 1801 (N.D. Ill. 1993), Judge Easterbrook stated that "decomposing an invention into its

constituent elements, finding each element in the prior art, and then claiming that it is easy to reassemble these elements into the invention, is a forbidden ex post analysis.”

Further, Judge Easterbrook stated *Id.* at 1817:

With hindsight the transistor is obvious; but devising the transistor was still a work of genius. An invention lies in a combination of elements that are themselves mundane. ... Unless the prior art itself suggest the particular combination, it does not show that the actual invention was obvious or anticipated.

It is impermissible to use the inventor’s disclosure as a “road map” for selecting and combining prior art disclosures. *Grain Processing Corp. v. American Maize-Products Corp.*, 5 USPQ2d 1788, 1792, (Fed. Cir. 1988); *American Medical Systems Inc. v. Medical Engineering Corp.*, 26 USPQ2d 1081, 1091 (E.D. Wis. 1992), *aff’d in part, rev’d in part & remanded*, 28 USPQ2d 1321 (Fed. Cir. 1993).

It is only with the Applicants’ disclosure that the Examiner can conclude that it would have been obvious to use a wireless connection or a hand held computer.

Therefore, it would not have been obvious to use a wireless connection or a hand held computer in D’Agostino. Further, Applicants have amended claims 1 and 9, the base independent claims from which claims 5, 6, 13, and 14 depend. Claims 1 and 9 were shown to be allowable above and the dependent claims are allowable for the same reasons. In view of the above amendments, remarks, and cited case law, it is believed that the rejection of claims 5, 6, 13, and 14 under 35 U.S.C. §103 as being unpatentable over D’Agostino should be withdrawn.

Applicants request reconsideration of the rejection of claim 15 under 35 U.S.C. §103(a) as being unpatentable over Thean et al. in view of Szymansky, U.S. Patent No. 6,557,029. Applicants point out that claim 15 depends from claim 9 that was previously

shown to be allowable. It is urged that claim 15 is allowable for the same reasons.

Further, the Examiner has again attempted to piece together an obviousness rejection. As argued above, such piecing together is impermissible. It is believed that the rejection of claim 15 should be withdrawn.

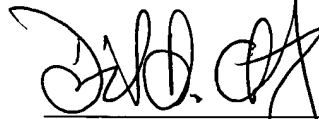
Applicants request reconsideration of the rejection of claims 18-20 under 35 U.S.C. §103(a) as being unpatentable over Gifford, U.S. Patent No. 5,724,424. Claim 18, the base independent claim, has been amended to include the patentable feature of the controlling step having different levels of control with a first level of control being sending screens to the customer computer, a second level of control being controlling operation of the web enabled program of the computer, and a third level of control being capturing complete control of the customer computer. The Gifford reference fails to teach such a method. Further, the Examiner has taken the position that the connection of a telephone call between a customer and a representative of a vendor is well known without citing any reference for this position. Again, this appears to be impermissible hindsight.

Claims 19 and 20 depend from independent claim 18 that has been shown to be allowable. It is submitted that claims 19 and 20 are allowable for the same reasons. In view of the amendment to claim 18, the rejection of claims 18-20 under 35 U.S.C. §103(a) should be withdrawn.

Applicants submit that upon entry and review of the amended claims and consideration of the above remarks this application should be in condition for allowance. In the event that this application is for any reason not considered by the Examiner to be in form for allowance, Applicants' counsel requests the Examiner to telephone the

undersigned before issuing a further action to discuss any objections the Examiner might have, thereby simplifying and expediting the examination and prosecution process.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'D.H. Chervitz', written over a horizontal line.

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